



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/423,194 04/18/95 EATON

D P0871P402

EXAMINER

SPECTOR, L

18N2/0322

ART UNIT PAPER NUMBER

DARYL B WINTER  
GENENTECH INC  
460 POINT SAN BRUNO BLVD  
SOUTH SAN FRANCISCO CA 94080-4990

1812

DATE MAILED:

03/22/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

*for restriction only*  
☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 2, 6, 17-19 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☒ Claims 3-5, 7-16, 20-37 have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1, 2, 6, 17-19 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

EXAMINER'S ACTION

**Part III: Detailed Office Action**

**Restriction Requirement:**

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1, 2, 6 and 17, drawn to mpl ligands and chimeras thereof, classified in  
5 Class 530, subclass 251 and Class 435, subclass 69.1.

II. Claims 18 and 19, drawn to antibodies and hybridoma cells, classified in Class  
530, subclass 388.23 and Class 435, subclass 240.27.

The inventions are distinct, each from the other because of the following reasons:

The proteins of Invention I are related to the antibodies of Invention II by virtue of being  
10 the cognate antigen, necessary for the production of the antibodies. Although the protein and  
antibody are related due to the necessary steric complementarity of the two, they are distinct  
inventions because they are physically and functionally distinct chemical entities, and because  
the protein can be used another and materially different process from the use for production of  
the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the  
15 cognate receptor of the protein (as the protein is itself a ligand), or in assays for the identification  
of agonists or antagonists of the receptor protein.

The cells of Invention II are distinct and unrelated to the proteins of Invention I, wherein  
the two groups represent distinct compositions, wherein neither may be used for the production  
of the other, and the two are made by and used in patentably distinct processes.

20 Because these inventions are distinct for the reasons given above and have acquired a  
separate status in the art as shown by their different classification and recognized divergent  
subject matter, restriction for examination purposes as indicated is proper.

In the event that election of Invention I is made, a further election of species is required  
25 as follows:

This application contains claims directed to the following patentably distinct species of  
the claimed invention: mpl ligands which are fragments, and mpl ligands which are chimeric  
polypeptides.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 2 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

A telephone call was made to Darryl Winter on 3/18/96 to request an oral election to the above restriction requirement, but did not result in an election being made.

Serial Number 08/423194  
Art Unit 1812

---

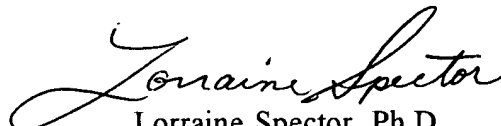
**Advisory Information:**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 8:00 A.M. to 4:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ms. Garnette D. Draper, can be reached at (703)308-4232.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0196.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The Art Unit 1812 Fax Center number is (703) 308-0294. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. Please advise the Examiner at the telephone number above when a fax is being transmitted.

  
Lorraine Spector, Ph.D.  
Patent Examiner

LMS  
423194.R  
3/20/96